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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

8
9
10 Ex parte CARL R. JACOBS and JACQUELINE COLLINS

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13 Appeal 2007-4391
14 Application 10/043,699
15 Technology Center 3600

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18 Oral Hearing Held: June 10, 2008
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22 Before HUBERT C. LORIN, LINDA E. HORNER, and MICHAEL W.
23 O'NEILL, Administrative Patent Judges

24
25 ON BEHALF OF THE APPELLANT:

26
27 WES MUSSELMAN, ESQUIRE (by video-teleconference)
28 Fish & Richardson, P.C.
29 1717 Main Street
30 Suite 5000
31 Dallas, TX 75201 45224

32
33 The above-entitled matter came on for hearing on Tuesday, June 10, 2008,
34 commencing at 1:41 p.m., at the U.S. Patent and Trademark Office, 600
35 Dulany Street, Alexandria, Virginia, before Victoria L. Wilson, Notary
36 Public.

PROCEEDINGS

MR. MUSSELMAN: This is Wes Musselman. I'm with Fish & Richardson in Dallas for the applicants. And I'm here with two of our law students that are working with us this summer, Frank Geng, who is seated to my right, and Jamie Youngblood, who is sitting across the table from me.

And Jamie wanted to apologize for not being in a suit and tie. I offered this opportunity to him just this morning and he didn't have a coat and tie with him at the office.

JUDGE LORIN: That's fine, Counsel. It is very nice to meet you all. The case number is 2007-4391. We have Judges Horner and O'Neill, and I am Judge Lorin presiding. The application number is 10/043,699. We are familiar with the case. You have 20 minutes. When you are ready, you may proceed.

MR. MUSSELMAN: Thank you.

I'm sure you will be relieved to hear that I need much less than 20 minutes for this particular appeal.

There is 24 claims pending, 2 independent claims, and they have some similar limitations for the purposes of the arguments. The focus of the claims, the independent claims, as they now stand is on a fuel dispenser that's providing information.

The information that's being provided on the display is unrelated to the fueling transaction, and it is also being displayed as a function of the manner of payment that is selected by the user of the fuel dispenser.

An example of something like that might be if a customer pays for a fueling transaction with an American Express card that's identified by the

1 numbers on the card as an American Express black card, which would be
2 some of the most elite American Express members, the display on the screen
3 could include an offer for a free stay at the Bellagio in a suite or it could
4 include a display of the Lexus automobile, the most expensive V12 Lexus
5 automobile.

6 I think the difference of opinion that we appear to have with the
7 examiner is in construction of claims 1 and 5 and whether -- or the
8 appropriate construction of the claim.

9 I don't know if you have claim 1 in front of you but I would like to
10 point out what we believe is the claim language that provides that this
11 unrelated information -- or that this information must meet two conditions to
12 fall within the claim. And it towards the end of claim 1.

13 The first is in the element, a controller operably coupled. It is at the
14 end of that where it says, "To display information on the display as a
15 function of the manner in which the user will pay." So to us that would be
16 condition one for the information on the display.

17 Condition 2 is in the end "wherein" clause where it says, "At least a
18 portion of the display information," indicating that there is an antecedent for
19 display information.

20 In other words, the display information that's been provided as a
21 function of the manner in which the user will pay is also unrelated to the
22 manner -- well, it is unrelated to the manner -- sorry -- let me start over.

23 The display information which is displayed as a function of the
24 manner of payment is also unrelated to the fueling transaction. So again, in
25 order to meet -- fall within this claim, the information would have to meet
26 two conditions.

1 It is being provided as a function of the manner of payment, in other
2 words, for instance, it may be provided when there is a cash transaction but
3 not when there's a credit transaction and it is unrelated to the fueling
4 transaction.

5 Now, the examiner relies on a single reference, Struthers. Struthers
6 does disclose providing some display information that's related to the
7 function of payments in some of the figures, for instance, on the front face of
8 the patent where they will have, you know, select your card, is it debit or
9 credit.

10 Struthers does mention that you can provide some information that's
11 unrelated to the fueling transaction, but what Struthers does not say is that
12 the information that's unrelated to the fueling transaction is provided based
13 as a function of the manner of payment.

14 And that's, in a nutshell, our disagreement with the examiner. It boils
15 down to, I believe, construction of claim 1 and a similar language in claim 5.

16 JUDGE LORIN: Okay. Counsel, are you through with your
17 presentation?

18 MR. MUSSELMAN: Yes.

19 JUDGE LORIN: Any questions?

20 JUDGE HORNER: I have no questions.

21 JUDGE LORIN: Well, Counsel, we have no questions. So thank you
22 very much.

23 MR. MUSSELMAN: Okay. Thank you.

24 JUDGE LORIN: We will take your comments under advisement.

25 MR. MUSSELMAN: Thank you.

26 (Whereupon, the proceedings at 1:47 p.m. were concluded.)